REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 15, 2004 ("*Office Action*"). Claims 1-24 were pending in the Application and stand rejected. Applicant amends Claims 1, 8, 13, and 20. Applicant respectfully requests reconsideration and favorable action in this case.

Information Disclosure Statement Filed 11/6/2000

The Examiner indicates that the Information Disclosure Statement ("IDS") filed on 11/6/2000 has not been considered. Applicant respectfully submits that the IDS fully complied with 37 C.F.R. §§1.97 and 1.98 as those regulations existed on the date the IDS was filed. However, the Examiner states that the reason the IDS has not been considered is because Applicant did not use a Form PTO-1449.

Applicant respectfully submits there is no requirement that cited documents be listed on Form PTO-1449. In this regard, the attention of the Examiner is respectfully directed to M.P.E.P. §609(III)(A)(1), which begins by stating that each IDS must include a "list" of all information submitted for consideration and ends by "encouraging" the use of Form PTO-1449 or some other similar form. Thus, there is a requirement for a list but not a requirement to use a Form PTO-1449. Applicant also respectfully directs the attention of the Examiner to M.P.E.P. §609(III)(C)(2), which specifically recognizes that Applicants are not required to use Form PTO-1449 by suggesting that Examiners "write 'all considered' and his or her initials to indicate that all citations have been considered" when "citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B."

Thus, Applicant respectfully requests the Examiner to review the IDS and provide Applicant with notice of such consideration as required by M.P.E.P. §609.

Claim Rejections - 35 U.S.C. §112

The Examiner rejects Claims 1-24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully submits that the §112 rejection of independent Claims 1, 8, 13, and 20 is obviated due to Applicant's amendments of these Claims. The Examiner only rejects Claims 2-7, 9-12, 14-19, and 21-24 under §112 for being

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dependent on Claims 1, 8, 13, and 20 respectively. Applicant therefore respectfully requests the Examiner to withdraw the §112 rejection of Claims 1-24.

Double Patenting

The Examiner provisionally rejects Claims 1, 8, 13, and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending Application No. 09/658,016. Applicant respectfully submits that, if necessary and appropriate, Applicant stands ready to file a terminal disclaimer to overcome any non-provisional double-patenting rejection.

Claim Rejection under 35 U.S.C. §103

The Examiner rejects Claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,848,198, which issued to Penn (*"Penn"*), in view of U.S. Patent No. 6,634,008, which issued to Dole (*"Dole"*). To establish obviousness of a claimed invention under §103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03.

Applicant's Claim 1, as amended, recites:

> A method, comprising the steps of:
> providing a set of predetermined function definitions, at least one of said predetermined function definitions defining a function for manipulating image data; and
> preparing a project definition, said project definition including:
> a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition;
> a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination, said image data from said data source being transferred to said source portion through a network; and

binding information which includes binding portions that each associate a respective said input port with one of said output ports;

wherein preparing said project definition comprises:

displaying a project window that includes a graphical representation of said project definition; and

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

wherein execution of said project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

Applicant respectfully submits that *Penn* in view of *Dole* fails to teach or suggest every element of this Claim. *Penn* teaches using fractal mathematics to detect, identify, and analyze anomalies and abnormalities within images such as X-rays. *Dole* teaches using forms stored on web servers to design integrated circuits.

Among other aspects of Claim 1, *Penn* in view of *Dole* fails to teach or suggest:

wherein preparing said project definition comprises:

displaying a project window that includes a graphical representation of said project definition; and

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

wherein execution of said project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

Penn in view of *Dole* also fails to teach or suggest "binding information which includes binding portions that each associate a respective said input port with one of said output ports." As teaching these elements, the Examiner cites *Penn*'s statement regarding "a header containing descriptive information for the particular image." *Penn*, Col. 19, lines 5-9. However, a header containing descriptive information for a particular image in no way shows "binding information which includes binding portions that each associate a respective said input port with one of said output ports."

Additionally, *Penn* in view of *Dole* fails to teach or suggest:

a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data

destination and defining an input port through which said image data can be supplied to the data destination.

As teaching the quoted elements, the Examiner cites the following language in *Penn*:

> In the present invention a matrix of pixel values representing an Analysis Image is analyzed and a matrix of pixel values representing corresponding pixels of an Original Image is processed. The matrices representing the Analysis Image and the Original Image can be the same or different. The invention performs the following steps for each source image . . .

Penn, Col. 6, lines 60-67. However, Applicant respectfully submits that the cited language simply fails to teach or suggest the quoted elements.

Applicant also respectfully submits that the there is no teaching, suggestion, or motivation to combine or modify the teachings of *Penn* and *Dole* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must show some teaching, suggestion, or motivation to combine or modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. §2143.01. The Examiner has not provided evidence that suggests the proposed combination. Furthermore, the allegation that the teachings of one reference might improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. "The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. §2143.01. Speculation in hindsight that it would have been obvious to make the proposed combination because the proposed combination would be helpful is insufficient under governing Federal Circuit case law.[1]

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[1] For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

> Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

Id. at 999 (emphasis added) (citations omitted).

In addition, Applicant respectfully submits that the proposed combination of *Penn* and *Dole* is improper because *Dole* is not analogous prior art. The Examiner is required to determine whether a reference is analogous. M.P.E.P. §2141.01(a). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992). Since *Dole* does not concern manipulation of image data, much less preparing a project definition that operates at least in part to manipulate image data, *Dole* is not in Applicant's field of endeavor, nor would it have commended itself to Applicant when determining how to manipulate image data. Furthermore, a person of ordinary skill, seeking to manipulate image data, would not reasonably be expected or motivated to look to design of integrated circuits, of which *Dole* is concerned.

For at least all of these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claim 1 and its dependent claims. For analogous reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claims 8, 13, and 20 and their respective dependent claims.

Conclusions

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any other fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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